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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/725,307

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James D. Ralph

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EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,307

Applicant(s)

RALPH ET AL.

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-22, 24, 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20-22,24,25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,689,134.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 20-22,24,25 are to be found in claims 1-19. The difference between claims 20-22,24,25 of the application and claims 1-19 of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 1-19 of the patent is in effect a "species" of the "generic" invention of claims 20-22,24,25. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 20-22,24,25 are anticipated by claims 1-19 of the patent, they are not patentably distinct from claims 1-19.

Claims 20-22,24,25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,666,867. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 20-22,24,25 are to be found in claims 1-18. The difference between claims 20-22,24,25 of the application and claims 1-18 of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 1-18 of the patent is in effect a "species" of the "generic" invention of claims 20-22,24,25. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 20-22,24,25 are anticipated by claims 1-18 of the patent, they are not patentably distinct from claims 1-18.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-22,24,25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (5,364,396) in view of Errico et al. (5,531,746).

With respect to claims 20,25 Robinson et al disclose a plate assembly comprising a first longitudinal plate (16) having an end defined by longitudinal prongs (44) a second longitudinal plate (18) having a longitudinal bore, as best seen in FIG.3,

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the longitudinal bore being adapted to receive the prongs for longitudinal translation therein through a plurality of positions; as set forth in column 4, lines 1-61; at least one bone fastener (59) for coupling the plate assembly to vertebral bone using the integral means (58) for coupling the plate assembly, means (32,34,36,38) for adjusting the length of the plate assembly, means (20,42) for locking the length of the plate assembly, wherein the means for locking the length of the plate assembly comprises a threaded bore (40) and a set screw (20) passing between the means for adjusting the length (44) of the plate assembly and into the threaded bore (40).

It is noted that Robinson et al did not teach of a bore or means for inserting at least one bone fastener into the vertebral bone polyaxially at any of a plurality of selectable angles of relative to the plate assembly; as claimed by applicant. However, in similar art, Errico et al evidences the use of a bore with a coupling element to provide a secure prevention against screw back-out, as well as locking the screw at the preferred non-perpendicular angulation with respect to the plate.

Therefore, given the teaching of Errico et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Luhr et al, as taught by Errico et al to provide a secure prevention against screw back-out, as well as locking the screw at the preferred non-perpendicular angulation with respect to the plate.

With respect to claims 21,22,24, the above combination of references teaches all the limitations, as set forth in column 3, lines 10-68; column 4, lines 1-68, column 5, lines 1-21, of Robinson et al.; and column 4, lines 40-45 of Errico et al.

Response to Amendment

Applicant's arguments with respect to claim 19-25 have been considered but are moot in view of the new ground(s) of rejection. Furthermore, Applicant's Terminal Disclaimer has not been approved because no reel and frame numbers were provided. The indicated allowability of claims 20, 25, is withdrawn in view of the newly discovered reference(s) to Robinson et al. Rejections based on the newly cited reference(s) follow (see above).

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
June 14, 2007


PEDRO PHILOGENE
PRIMARY EXAMINER